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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MANUEL VALCACEL c/o GREENBERG TRAURIG, P.A. 1221 BRICKELL AVENUE MIAMI, FL 33131			EXAMINER ARAQUE JR, GERARDO	
			ART UNIT 3689	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/078,142

Applicant(s)

AMENGUAL ET AL.

Examiner

GERARDO ARAQUE JR

Art Unit

3689

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26, 81 and 82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 81 and 82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claim 1, 15, and 81** are rejected under 35 U.S.C. 101 because if the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 USC 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. In the present case, the applicant discloses:

"means for providing customizable criteria for comparison..."

Claim Objections

4. **Claim 82** is objected to because of the following informalities: **the term "Obtaining" should read as "obtaining" in Step A of the claim.** Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1 – 26 and 81 – 82** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. **Claims 1, 14, 15, 81, and 82** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a means for comparing.
8. **Claim 1, 14, 15, 81, and 82** recites the limitation "based on said comparison" in **Step E of the mentioned claims**. There is insufficient antecedent basis for this limitation in the claim.
9. **Claim 1, 14, 15, 81, and 82** recites the limitation "**said additional websites**" in **Step E of the mentioned claims**. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
11. **Claims 1 - 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pant et al. (US Patent 6,012,053)**.
12. In regards to **claims 1, 7, 14, 15, 16, 22, Pant** discloses a customizable computerized system for providing access to specified Internet websites and

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comparable alternative websites utilizing telephone numbers as search queries, comprising:

means for storing data comprising Internet domain names for available websites, and telephone numbers corresponding to said websites, and data regarding products or services offered by said websites in a database (**Col. 3 Lines 25 - 27**);

means for receiving a system user search query for a specified Internet website in the form of a telephone number corresponding to said website's proprietor (**Col. 3 Lines 33 - 34**);

means for processing said user search query to provide access to said specified Internet website in response to said query (**Col. 5 Lines 22 - 25**);

means for providing customizable criteria for comparison of said specified website with other websites (**Col. 1 Lines 53 - 56; Col. 3 Lines 20 - 22**);

means for providing, in response to said telephone number query, a referential directory of said additional website that are comparable alternatives to said specified Internet website based on said comparison of said data regarding products or services offered by said specified website and said additional websites, in addition to said specified Internet website, said additional Internet websites being further selected based on said customizable criteria, said referential directory listing both the website name and telephone number for said additional Internet websites (**Col. 3 Lines 34 - 37**); and

means for providing access to additional Internet websites displayed in said referential directory (**Col. 3 Line 39; Col. 13 Lines 5 - 8**).

However, **Pant** fails to explicitly disclose a specific search query, i.e. telephone numbers.

However, it would have been obvious to one having ordinary skill in the art that a search query can consist of many different types of alpha/numeric search terms. That is to say, a search query can consist of words, numbers, symbols, and/or any combination thereof. As a result, the Examiner asserts that it is well known that a user who would be using an Internet search engine to look up the location of say, a fast food establishment within a certain area code would input area code 703 and burgers, for example. Further still, it is also well known for the url of many websites to be the phone number of the business, such as 1-800-FLOWERS or 1-800-MATTRES. As a result, the Examiner notes that the act of claiming a specific search term, i.e. telephone number, is nonfunctional descriptive subject matter.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of **Pant** to use specific search terms, such as a telephone number, for when the user is searching for a specific site on the Internet.

13. In regards to **claims 2 and 17**, the Examiner asserts that it is old and well known to use web address forwarding.

14. In regards to **claims 3 and 18**, **Pant** discloses means for displaying to users content from said Internet websites in a standardized format (**Col. 6 Lines 40 – 50**)

15. In regards to **claims 4 and 19**, **Pant** discloses wherein said customizable criteria are provided by electronic communication from said user **(obviously included since the searching is being done on a computer; See also at least Col. 2 Lines 25 - 30)**.

16. In regards to **claims 5 and 20**, **Pant** discloses wherein said customizable criteria are preprogrammed into said system **(See at least Col. 1 Lines 37 – 40)**.

17. In regards to **claims 6 and 21**, **Pant** discloses wherein said means for providing a referential directory of additional Internet websites that are comparable to said specified Internet website, based on one or more customizable criteria for comparison comprises

one or more databases containing data regarding characteristics of a plurality of Internet websites and one or more software applications that select said additional websites based on comparison of data pertaining to said specified website and data pertaining to said additional websites **(Col. 3 Lines 20 – 32)**.

18. In regards to **claims 8 – 11 and 23 – 26**, the Examiner asserts that it is old and well known for search engines to provide a listing of websites that are relevant to the user's search query. That is to say, the user can define all of the appropriate search terms for the search engine to search for. As a result, if the user's search query consists of products, services, prices, content, publication, or any combination thereof the search engine would then process the search query and provide the user with all websites that are relevant to the search query.

In regards to **claim 12**, the Examiner asserts that online internet e-mail providers are old and well known in the art, such as Hotmail, Gmail, MSN, and etc. Further still, it

is also well known for many companies to have a contact list consisting of e-mail, fax, or phone numbers. As a result, as explained above, as long as the search query exists somewhere on the Internet the search engine will search for it within its databases and provide them to a user. Further still, the Examiner also asserts that an e-mail address can consist of any alpha/numeric combination that has not been used, including a phone number. Thus, if a user's email address consisted of phonenumber@hotmail.com, for example, the search engine would then search for that specific search term.

19. In regards to **claim 13**, the Examiner asserts that it is old and well known for an e-mail message to be sent to multiple recipients and that a single recipient can have several e-mail accounts.

Response to Arguments

20. Applicant's arguments with respect to claims **1 – 26 and 81 – 82** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure can be found in the PTO-892 Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARDO ARAQUE JR whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. A./
Examiner, Art Unit 3689
3/15/08

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3629